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Robert Icho

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EXAMINER

JANVIER, JEAN D

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* ROBERT ICHO
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11 Appeal 2008-5181
12 Application 09/815,838
13 Technology Center 3600
14

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16 Decided:¹ February 19, 2009
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19 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.

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22 FETTING, *Administrative Patent Judge*.
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25 DECISION ON APPEAL
26

27 STATEMENT OF THE CASE

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Robert Icho (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection of claims 1-3 and 7-14, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellant invented a system and method for providing a purchase award program that may be applied to any purchases carried out through the Internet (Specification Page 3, lines 3-5).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method for providing an on-line purchase award incentive program, including the steps of:

[1] providing a program web site;

[2] accepting user registration with said program and storing the name and e-mail address of each registered user in association with a respective program account;

[3] providing a web page listing a plurality of vendors, all of said vendors participating in said program, said web page enabling click-through connection to the web sites of any of said participating vendors;

[4] establishing an e-mail address for said program web site;

[5] each registered user electively transacting at least one purchase directly with the web site of one of said participating vendors;

[6] each registered user using said e-mail address of said program web site during each purchase transaction with a web site of one of said participating vendors;

[7] reporting said at least one purchase to said program web site via e-mail after the purchase is completed;

[8] crediting the account of the respective registered user with purchase award points according to the dollar amount of said at least one purchase;
[9] reiterating said steps of purchasing, reporting, and crediting to accumulate purchase award points in the respective account of each registered user; and,
[10] each registered user electively redeeming purchase award points in the respective account for goods and/or services.

This appeal arises from the Examiner's Final Rejection, mailed May 23, 2005. The Appellant filed an Appeal Brief in support of the appeal on May 1, 2006. An Examiner's Answer to the Appeal Brief was mailed on November 1, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Ikeda	US 5,937,391	Aug. 10, 1999
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REJECTION

Claims 1-3 and 7-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ikeda.

ISSUE

The issue pertinent to this appeal is whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over Ikeda. This issue turns on whether the Examiner's taking of Official Notice on the feature of confirming a purchase transaction via email is proper and whether the Appellant challenged the Examiner's taking of Official Notice.

FACTS PERTINENT TO THE ISSUE

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Ikeda

01. Ikeda is directed towards a point service system for sales promotion and marketing (column 1, lines 6-9).
02. A points issuing unit determines the number of points to allocate for purchase. For example, the points issuing unit determines the number of points to allocate for the purchase of 100 yen (column 3, lines 52-57). A flag is set to determine whether payment has been made and once payment has been completed, points are added to the customer's total (column 10, lines 47-54). This can be accomplished by a shop or a financial company transmitting a payment notification to the online shopping mall server (column 12, lines 36-51).
03. A points management device stores the number of points accumulated by each customer for each points issuing shop (column 3, lines 58-60). A points management table maintains information regarding the number of points issued for each transaction with each shop and the total number of accumulated points per customer (column 7, lines 40-42 and column 8, lines 48-50). The total accumulated points per customer is stored in the INFORMATION column (figure 8).
04. A points redeeming unit determines how much to reduce the purchase price of a product based on the number of accumulated

points by the customer. The points redeeming ratio is determined by the shopping mall or shop (column 3, lines 61-67).

05. A webpage is used to display the shopping mall (column 4, lines 1-5). Shops that are part of the online mall may or may not provide a point service system (column 7, lines 5-10). The system makes a determination of whether a shop is a point service vendor during point issuance and point redemption (figures 7 and 14).

06. The homepage consists of information regarding the online shopping mall. All of the shops are listed on the homepage. The homepage further presents to the customer the total number of points awarded to the customer and from which shops the awards were issued from (figure 6 and column 6, lines 29-38). All of the vendors and their point system are displayed, including shops that do not participate in the point service program such as Shop E (figure 6).

07. The architecture of the system includes a plurality of servers. The system can be run on a server where the shops do not have their own servers or on a system where each shop has their own servers (column 4, lines 55-60). The amount of points awarded from each shop is altered from the server of each shop and maintained on the server of the mall (column 12, lines 53-60).

08. Ikeda describes previous systems awards gifts once the number of points break a predetermined threshold (column 1, lines 15-17 and column 1, lines 20-22).

Facts Related To The Level Of Skill In The Art

09. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of ecommerce or online sales. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

10. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill

1 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*
2 *Inc.*, 127 S. Ct. at 1734. “The combination of familiar elements according to
3 known methods is likely to be obvious when it does no more than yield
4 predictable results.” *KSR*, at 1739.

5 “When a work is available in one field of endeavor, design incentives
6 and other market forces can prompt variations of it, either in the same field
7 or a different one. If a person of ordinary skill can implement a predictable
8 variation, § 103 likely bars its patentability.” *Id.* at 1740.

9 “For the same reason, if a technique has been used to improve one
10 device, and a person of ordinary skill in the art would recognize that it would
11 improve similar devices in the same way, using the technique is obvious
12 unless its actual application is beyond his or her skill.” *Id.*

13 “Under the correct analysis, any need or problem known in the field
14 of endeavor at the time of invention and addressed by the patent can provide
15 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

16
17 ANALYSIS

18 *Claims 1-3 and 7-14 stand rejected under 35 U.S.C. § 103(a) as*
19 *unpatentable over Ikeda*

20 The Examiner found that Ikeda described all of the limitations of
21 claim 1-3 and 7-14, except for the features of each registered user using the
22 email address of the program website during each purchase transaction with
23 participating vendors, reporting the purchase to the program website via
24 email after the purchase, and a subsequent confirmation email is sent to the
25 registered user from the program website of claims 1, 7-8, and 13 (Answer
26 Page 6, last paragraph). The Examiner took Official Notice that these

1 features were old and well-known in the art at the time of the invention
2 (Answer Page 7). The Examiner then found that one of ordinary skill in the
3 art would have found it obvious to modify Ikeda in order to increase the
4 accuracy of the system by properly awarding points to registered users
5 (Answer Page 8).

6 The Appellant contends that: (1) Ikeda counts points for each shop
7 separately, whereas the claimed invention sums the total dollar spent through
8 the web site (Br. Page 11, second paragraph), (2) Ikeda fails to describe that
9 all of the online shops are point providers (Br. Page 11, second paragraph),
10 (3) Ikeda reduces the price of items in exchange for reward points, whereas
11 the claimed invention does not interfere with a customer's transaction with a
12 vendor (Br. Page 11, last paragraph and Br. 13, first paragraph), (4) Ikeda
13 keeps track of points being accumulated or spent during an ongoing
14 transaction, whereas the claimed invention relies on an email confirmation
15 of a completed transaction after the transaction occurs and miles or points
16 are awarded subsequent to the transaction (Br. Page 11, last paragraph) as
17 per claims 1 (Br. Page 13, first paragraph), 7-8 (Br. Page 13, second
18 paragraph), 12 (Br. Page 13, third paragraph), 13 (Br. Page 13, last
19 paragraph), and 14 (Br. Page 13, last paragraph), and (5) Ikeda uses points or
20 miles to buy goods from participating online shops, whereas the claimed
21 invention acquires miles by purchase (Br. Page 11, last paragraph).

22 The Appellant first contends (1) Ikeda counts points for each shop
23 separately, whereas the claimed invention sums the total dollar spent through
24 the web site (Br. Page 11, second paragraph). We disagree with the
25 Appellant. Ikeda describes displaying the number of points issued by each
26 shop and accumulated total points for each customer (FF 03 and FF 06).

1 The total accumulated points are listed in the INFORMATION column (FF
2 03). As such, Ikeda explicitly describes maintaining the sum of the total
3 points accumulated as recited by the claimed invention. The Appellant
4 appears to be arguing that Ikeda performs additional steps in recording
5 points at the shop level before summing the point (Br. Page 11, first full
6 paragraph). Claim 1 uses the open ended transition “including” which
7 allows for additional steps beyond those recited in the body of the claim.

8 The Appellant further contends (2) Ikeda fails to describe that all of
9 the online shops are point providers (Br. Page 11, second paragraph). We
10 disagree with the Appellant. We agree that Ikeda enables shops in the online
11 shopping mall to choose to participate or not participate in the point service
12 (FF 05). However, upon a customer entering the online shopping mall the
13 customer is presented with the mall homepage which displays the total
14 amount of points issued from each shop (FF 06). All of the shops that
15 participate in the online mall program are listed, including those that do not
16 award points for purchases (FF 06). The shops that are not participating in
17 the point service are indicated as not participating (FF 06). As such, Ikeda
18 describes listing all vendors in the online mall program. Limitation [3] in
19 claim 1 requires providing a web page listing a plurality of vendors, and that
20 all of those vendors participate in said program. The said program is first set
21 forth in limitation [1] as providing a program web site. Limitation [1] does
22 not further narrow the nature of the program. Therefore, since all of the
23 vendors in Ikeda listed are within the online mall program, limitation [3] is
24 met. But even were the program in limitations [1] and [3] construed to mean
25 an on-line purchase award incentive program, limitation [3] only requires
26 that, of all of the vendors in the plurality that are listed, all of those are in

1 that program. That is, some plurality of vendors is listed on a web page, and
2 all of those in that plurality participate. Limitation [3] does not preclude the
3 display of an additional plurality of vendors, beyond the list of participating
4 vendors, that are not in the program.

5 The Appellant additionally contends (3) Ikeda reduces the price of
6 items in exchange for reward points, whereas the claimed invention does not
7 interfere with a customer's transaction with a vendor (Br. Page 11, last
8 paragraph and Br. 13, first paragraph). We disagree with the Appellant.
9 Ikeda describes that the configuration of the points service system can
10 include a plurality of servers from each of the shops (FF 07). Furthermore,
11 each shop can set the server to alter the contents of the points management
12 system (FF 07). As such, the Ikeda system describes an implementation to
13 enable the shops to provide their own servers to be independent of the mall
14 server. This describes limitation [4] of claim 1 of the present invention.

15 The Appellant further contends (4) Ikeda keeps track of points being
16 accumulated or spent during an ongoing transaction, whereas the claimed
17 invention relies on an email confirmation of a completed transaction after
18 the transaction occurs and miles or points are awarded subsequent to the
19 transaction (Br. Page 11, last paragraph) as per claims 1 (Br. Page 13, first
20 paragraph), 7-8 (Br. Page 13, second paragraph), 12 (Br. Page 13, third
21 paragraph), 13 (Br. Page 13, last paragraph), and 14 (Br. Page 13, last
22 paragraph).

23 We disagree with the Appellant. The Examiner has not relied on
24 Ikeda to describe these limitations (Answer Page 7). The Examiner has
25 taken Official Notice that it is old and well-known in the art to transmit a
26 user's purchase transaction with a shop to the shopping mall via email

(Answer Page 7, last paragraph). The Examiner articulated that it is old and well-known in the art to use email as a vehicle for communication and for a customer to receive a confirmation email regarding a purchase (Answer Page 7, first paragraph). The Examiner also reasoned that it is old and well-known in the art to embed identification information while referring a user to another website and to email reports on the referring information for compensation purposes (Answer Page 7, second and third paragraphs). The Examiner's taking of Official Notice has not been challenged by the Appellant and thus are taken to be admitted prior art. *See In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943). As such, Appellant's arguments regarding the deficiencies of Ikeda does not persuade us of error on the part of the Examiner because the Appellant responds to the rejection by attacking the references separately, even though the rejection is based on the combined teachings of the references. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The Appellant additionally contends (5) Ikeda uses points or miles to buy goods from participating online shops, whereas the claimed invention acquires miles by purchase (Br. Page 11, last paragraph). We disagree with the Appellant. The claimed invention recites an incentive award is awarded and ordered from the program website by redeeming points. Ikeda describes the same concept of awarding a discount or an item when the number of accumulated points crosses a threshold (FF 04 and FF 08). As such, Ikeda describes this limitation and the Appellant's argument is not found persuasive.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over Ikeda for the above reasons.

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over Ikeda is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

AFFIRMED

hh

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